



7-15-02

Gp13602  
5014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**APPLICANT:** Sprogis **GROUP:** 3602  
**SERIAL NO:** 09/627,870 **EXAMINER:** Gravini, S.

**FILED:** July 28, 2000

**FOR:** SYSTEM AND METHOD FOR DIGITALLY  
PROVIDING AND DISPLAYING ADVERTISEMENT  
INFORMATION TO CINEMAS AND THEATRES

**Box DAC (Petitions to Make Special)  
Assistant Commissioner of Patents  
Washington, D.C. 20231**

**RECEIVED**  
**JUL 22 2002**  
**GROUP 3600**

**PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT  
PURSUANT TO 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 II**

Applicant hereby petitions to make this application special because of actual infringement.

Accompanying this petition are:

- 1) A Statement of Facts in Support of the Petition to Make Special Because of Actual Infringement;
  - 2) A Statement of Opinion of Infringement in Support of the Petition to Make Special Because of Actual Infringement; and
  - 3) A check for \$ 130.00 for the Petition fee.

Authorization is hereby given to charge deposit Account No. 19-0079 for any further charges that are required in connection with this Petition to Make Special.

Respectfully submitted,

William E. Hilton  
Registration No. 35,192  
Samuels, Gauthier & Stevens  
225 Franklin Street, Suite 3300  
Boston, Massachusetts 02110  
Telephone: (617) 426-9180  
Extension 111



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:

Sprogis

GROUP:

3602

SERIAL NO:

09/627,870

EXAMINER:

Gravini, S.

FILED:

July 28, 2000

FOR:

SYSTEM AND METHOD FOR DIGITALLY  
PROVIDING AND DISPLAYING ADVERTISEMENT  
INFORMATION TO CINEMAS AND THEATRES

RECEIVED

JUL 22 2002

GROUP 3600

Box DAC (Petitions to Make Special)  
Assistant Commissioner of Patents  
Washington, D.C. 20231

STATEMENT OF OPINION OF INFRINGEMENT IN SUPPORT OF  
PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT  
PURSUANT TO 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 II

I, William E. Hilton (PTO Reg. No. 35,192) of Samuels, Gauthier & Stevens, 225  
Franklin Street, Suite 3300, Boston, Massachusetts, hereby state as follows.

1. I am an appointed attorney authorized to represent the applicant before the U.S.

Patent and Trademark Office in connection with the prosecution of the above referenced  
application.

2. I have made a rigid comparison of the infringing DTDS product of NCN, Inc.

referred in the accompanying Statement of Facts with the claims of this application.

07/18/2002 RMEBRAHT 00000046 09627870

01 FC:122

130.00 OP  
*W*

3. In my opinion, at least claims 1, 2, 4, 6, 7, 15, 17, 22, 25 and 26 on file in this application are unquestionably infringed by the infringing DTDS product. More claims may also be infringed depending on whether the DTDS product includes additional features not disclosed in the literature that is attached to the accompanying Statement of Facts. A copy of an analysis of these claims in connection with the DTDS product is attached hereto.

4. A search of the pertinent prior art has been conducted and all such material prior art was provided to the Examiner in an Information Disclosure Statement with the application as filed on July 28, 2000.

5. No office action has yet issued in connection with this application and applicant understands from a representative of Art Group 3602 that it may be another 11 months before a first office action is issued.

6. I believe that each of the claims in this application as on file is allowable.

Respectfully submitted,



---

William E. Hilton  
Registration No. 35,192  
Samuels, Gauthier & Stevens  
225 Franklin Street, Suite 3300  
Boston, Massachusetts 02110  
Telephone: (617) 426-9180  
Extension 111

## Comparison of claims to alleged infringing product

Claim 1	DTDS Product of NCN, Inc.
A system for communicating with, and providing data representative of advertisement information to, movie projection equipment in theatres, said system comprising:	Yes The DTDS system provides advertisement information to movie projection equipment in theatres. See the Statement of Facts, ¶3, ¶4, Exhibit D
a computer storage unit for receiving and storing data representative of advertisement information;	Yes The DTDS system includes a computer storage unit that communicates with its servers. See the Statement of Facts, ¶5, Exhibit D
a plurality of digital projector assemblies coupled to said computer storage unit for receiving data from said computer storage unit;	Yes The DTDS system delivers digital content to digital projectors at movie theatres. See the Statement of Facts, ¶6, Exhibit D
a movie identification input unit for receiving information regarding a movie that is to be shown in a theatre environment associated with a first of said plurality of digital projector assemblies; and	Yes The DTDS system enables advertisers to target audiences on specific movie screens. See the Statement of Facts, ¶7, Exhibit D
a controller for selecting certain stored data for transmission to said first digital projector assembly responsive to said movie identification input unit	Yes The DTDS system includes servers that manage and distribute the digital data. See the Statement of Facts, ¶8, Exhibit D

Claim 2	DTDS Product of NCN, Inc.
A system as claimed in claim 1, wherein said first of said plurality of digital projector assemblies includes a computer processing unit in communication with a digital projector.	Yes The DTDS digital projectors are operated by computer processors. See the Statement of Facts, ¶6, Exhibit D

Claim 4	DTDS Product of NCN, Inc.
A system as claimed in claim 3, wherein said controller for selecting certain stored data for transmission to said first digital projector assembly is further responsive to the information regarding the assigned time.	<p style="text-align: center;">Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p>

Claim 6	DTDS Product of NCN, Inc.
A system as claimed in claim 5, wherein said controller for selecting certain stored data for transmission to said first digital projector assembly is further responsive to the information regarding the assigned location.	<p style="text-align: center;">Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p>

Claim 7	DTDS Product of NCN, Inc.
A system as claimed in claim 1, wherein said system further includes a network coupled to said computer storage unit and to said plurality of digital projector assemblies.	<p style="text-align: center;">Yes</p> <p>The DTDS system includes networked digital video servers that are controlled remotely via satellite.</p> <p>See the Statement of Facts, ¶9, Exhibit D</p>

Claim 15	DTDS Product of NCN, Inc.
A method of providing data representative of advertisement information to movie projection equipment in theatres, said system comprising the steps of:	<p style="text-align: center;">Yes</p> <p>The DTDS system provides advertisement information to movie projection equipment in theatres.</p> <p>See the Statement of Facts, ¶4, Exhibit D</p>
initializing a computer storage unit for receiving and storing data representative of advertisement information;	<p style="text-align: center;">Yes</p> <p>The DTDS system includes a computer storage unit that is initialized and receives and stores data representative of advertisement information.</p> <p>See the Statement of Facts, ¶5, Exhibit D</p>
receiving data from the computer storage unit at a plurality of digital projector assemblies;	<p style="text-align: center;">Yes</p> <p>The DTDS system delivers digital content to digital projectors at movie theatres.</p> <p>See the Statement of Facts, ¶6, Exhibit D</p>
generating movie identification information regarding a movie that is to be shown in a theatre environment associated with a first of the plurality of digital projector assemblies; and	<p style="text-align: center;">Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p>
selecting certain stored data from the computer storage unit for transmission to the first digital projector assembly responsive to the movie identification information.	<p style="text-align: center;">Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p>

Claim 17	DTDS Product of NCN, Inc.
A system for providing advertisement information to an audience, said system comprising:	<p>Yes</p> <p>The DTDS system provides advertisement information to movie projection equipment in theatres.</p> <p>See the Statement of Facts, ¶4, Exhibit D</p>
storage means for receiving and storing advertisement information regarding a plurality of advertisements;	<p>Yes</p> <p>The DTDS system includes a computer storage unit that communicates with its servers.</p> <p>See the Statement of Facts, ¶5, ¶6, Exhibit D</p>
common interest identification means for identifying a characteristic that each of the members of a first audience has in common, and for producing common interest information;	<p>Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p>
selection means for selecting a subset of the advertisement information responsive to the common interest information; and	<p>Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p>
display means for permitting the selected subset of the advertisement information to be displayed to the first audience.	<p>Yes</p> <p>The DTDS system causes the selected advertisements to be displayed at theatres by the digital projectors.</p> <p>See the Statement of Facts, ¶6, Exhibit D</p>

Claim 22	DTDS Product of NCN, Inc.
A system as claimed in claim 17, wherein said common interest information includes information regarding a movie.	<p>Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p>

Claim 25	DTDS Product of NCN, Inc.
A method of providing advertisement information to an audience, said method comprising the steps of:	<p>Yes</p> <p>The DTDS system provides advertisement information to movie projection equipment in theatres.</p> <p>See the Statement of Facts, ¶4, Exhibit D</p>
providing a storage medium for storing advertisement information regarding a plurality of advertisements;	<p>Yes</p> <p>The DTDS system includes a computer storage unit that communicates with its servers.</p> <p>See the Statement of Facts, ¶5, Exhibit D</p>
identifying a common interest characteristic that each of the members of a first audience has in common;	<p>Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p>
generating common interest data representative of said common interest characteristic; and	<p>Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p>
selecting a subset of the advertisement information responsive to the common interest data.	<p>Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p>

Claim 26	DTDS Product of NCN, Inc.
A method as claimed in claim 25, wherein said method further includes the step of displaying the selected subset of the advertisement information to the first audience.	<p>Yes</p> <p>The DTDS system causes the selected advertisements to be displayed at theatres by the digital projectors.</p> <p>See the Statement of Facts, ¶6, Exhibit D</p>



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Sprogis GROUP: 3602  
SERIAL NO: 09/627,870 EXAMINER: Gravini, S.

FILED: July 28, 2000

FOR: SYSTEM AND METHOD FOR DIGITALLY  
PROVIDING AND DISPLAYING ADVERTISEMENT  
INFORMATION TO CINEMAS AND THEATRES

Box DAC (Petitions to Make Special)

Assistant Commissioner of Patents

Washington, D.C. 20231

STATEMENT OF FACTS IN SUPPORT OF  
PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT  
PURSUANT TO 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 II

I, David H Sprogis, of 36 Chester Street, Watertown, Massachusetts. hereby state as follows.

1. I am the sole inventor of the subject matter of the above referenced patent application, which claims priority to U.S. Provisional Application Ser. No. 60/148,807 filed August 13, 1999.
  
2. There is an actual infringement of this invention by NCN, Inc. of Alexandria Virginia (See attached Exhibits A and B which show website information available at [www.ncninc.com](http://www.ncninc.com)).

3. NCN, Inc. offers for sale a product called DTDS and/or offers for sale the service of using the product called DTDS (See attached Exhibits C and D).

4. The DTDS product provides advertisement information to movie projection equipment in theatres. See Exhibit D.

5. The DTDS system includes a computer storage unit that, once initialized, receives data and communicates with its servers. See Exhibit D.

6. The DTDS system delivers digital content to digital projectors at movie theatres, and the digital projectors are controlled by computer processors. See Exhibit D.

7. The DTDS system enables advertisers to target audiences on specific movie screens. See Exhibit D.

8. The DTDS system includes servers that manage and distribute the digital data. See Exhibit D.

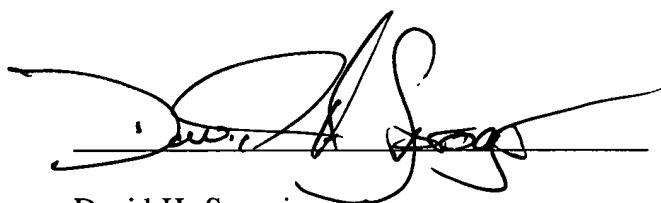
9. The DTDS system includes networked digital video servers that are controlled remotely via satellite. See Exhibit D.

10. The DTDS product was first discovered to be commercially available in about September 2000.

Respectfully submitted,

Date:

7/12/02

A handwritten signature in black ink, appearing to read "David H. Sprogis". The signature is fluid and cursive, with a large, stylized 'S' at the end.

David H. Sprogis  
36 Chester Street  
Watertown, MA 02472

**NATIONAL CINEMA NETWORK INC.**

**REACHING MOVIEGOERS EVERYWHERE THEY GO**

**ONLINE WITH NCN**

**CONTACT US | SITE MAP | ONLINE SURVEY**

This site requires a web browser that supports cookies and java and is best viewed with 24bit color.

Reach moviegoers online! Your brand will make a splash when it's displayed on NCN's unique network of movie-related sites.

**Click here for more**

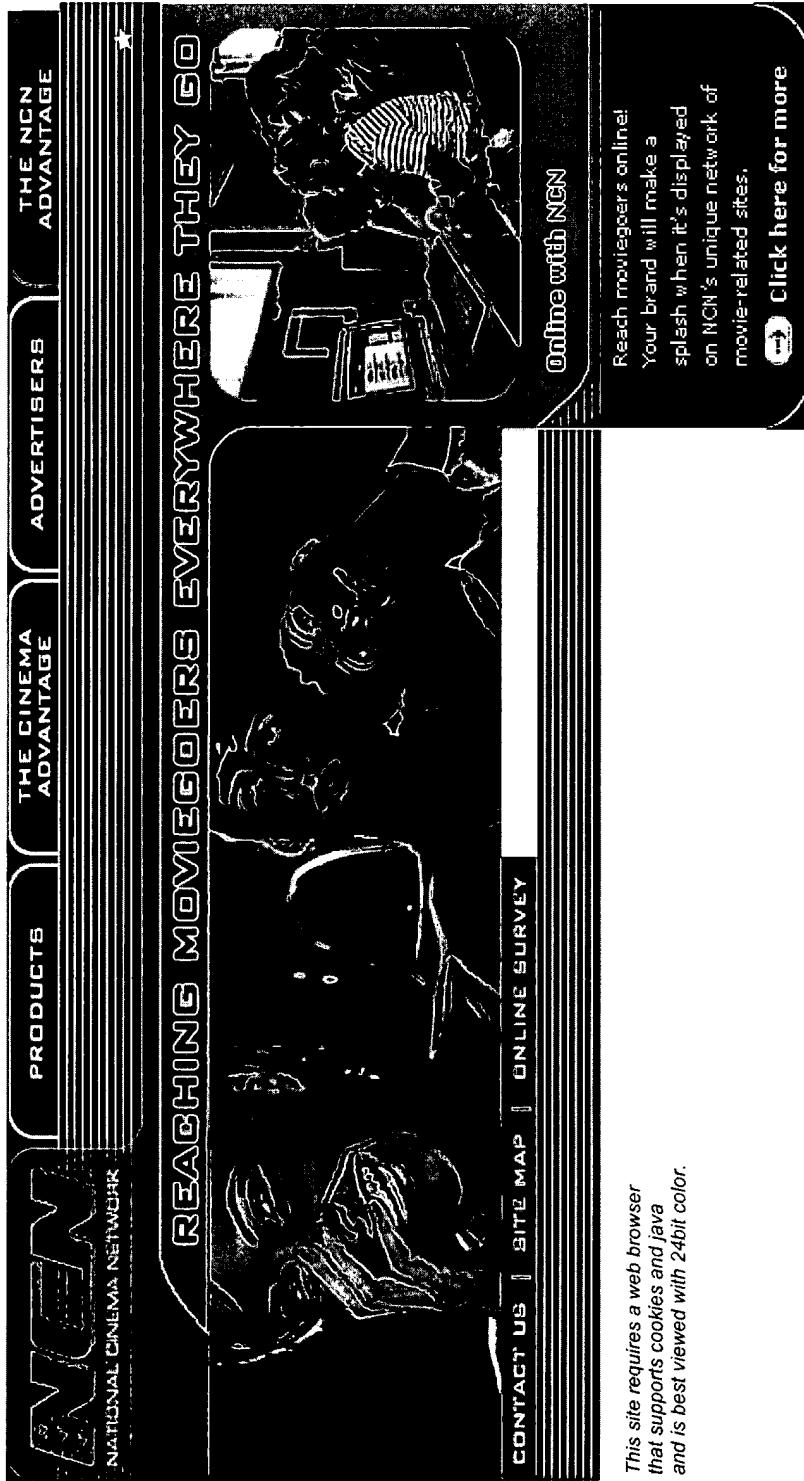
**THE CINEMA ADVANTAGE**

**ADVERTISERS**

**THE NCN ADVANTAGE**

**PRODUCTS**

**NATIONAL CINEMA NETWORK INC.**





<a href="#">Home Page</a>	<a href="#">Products</a>	<a href="#">Production Specs</a>
<a href="#">FAQ's</a>		
<a href="#">Image Gallery</a>		
<a href="#">DTS Video Stream</a>		
<a href="#">Sample Pre&gt;Show Ads</a>		
<a href="#">Sample Slide Show</a>		
<a href="#">NCN Slide Archive</a>		
<a href="#">NCN Customer Listing</a>		
<a href="#">Job Opportunities</a>		
<a href="#">Contact NCN</a>		
<a href="#">NCN Administration</a>		

## Contact NCN Professional Support

**Washington, DC Production Studio**  
National Cinema Network  
4900 Seminary Road, Suite 1110  
Alexandria, Virginia 22311  
c/o Production Administration  
(703) 379-8570 - fax

**Kansas City Production Studio**  
National Cinema Network  
1300 E. 104th Street, Suite 100  
Kansas City, Missouri 64131  
c/o Production Administration  
(816) 941-8219 - fax

**Washington, DC Production Studio**  
9 am - 5:30 pm (M - F) EST

**Kansas City Production Studio**  
8:30 am - 5 pm (M - F) CST

**Email Support:**

[NCNads@ncninc.com](mailto:NCNads@ncninc.com)  
Washington, DC Production Studio  
[KCdigital@ncninc.com](mailto:KCdigital@ncninc.com)  
Kansas City Production Studio

**Resource Center:**

Frequently Asked Questions  
Glossary of Terms



Product Specifications

---

**Send a File to NCN:**

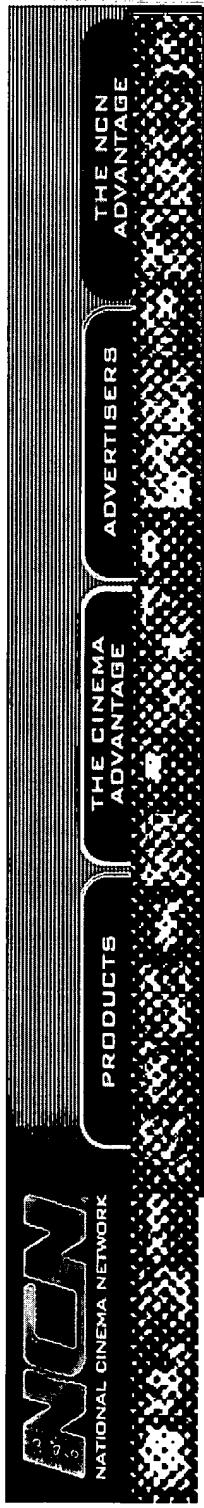
---

**NCN FTP Upload Center**

---

For sales information regarding NCN media, please visit: [www.NCNinc.com](http://www.NCNinc.com)

©2001 NCN. All Rights Reserved.



## The NCN ADvantage

When it comes to cinema advertising, NCN is the only choice for premier products and service. NCN pioneered the North American cinema advertising industry, successfully introducing ground-breaking media and promotions in movie theatres while respecting and maintaining the entertaining environment.

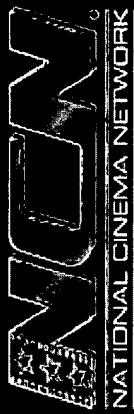
## Innovative, Effective Products

Since its inception in 1985, NCN has been committed to creating effective, top-quality cinema media. Its integrated product line, Cinema Media Solutions, includes film (rolling stock), slides, audio, signage, promotional packages and Internet opportunities, reaching moviegoers everywhere they go.

NCN is the only cinema advertising company providing advertisers the ability to reinforce their in-theatre campaigns with an online presence.

NCN continues its commitment to innovation and quality with the introduction of a digital management system, DTDS™. It's an easy-to-use tool to manage content displayed within a movie theatre.

## Superior Service

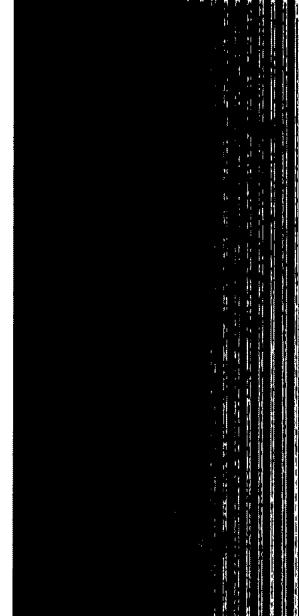


NATIONAL CINEMA NETWORK

Reaching Moviegoers Everywhere They Go

© 2002 NCN Inc. All rights reserved. ncninc.com

Complete our short survey for a chance  
to win a gift from NCN



At NCN, the spotlight is on you and your ad. NCN has a team of experienced, service-oriented professionals working for you, from your dedicated Account Executive and Sales Associate, to skilled production and traffic staff. We're there for you from the concept stage through your big screen debut.

### **Quality Assurance**

NCN backs its products with a quality assurance program - the only one in the cinema advertising industry - to ensure your needs are met.

### **Premier Theatres**

Representing more than 10,000 screens in North America, NCN's network includes top theatres in top markets and exhibitors with above-average attendance. NCN's Pre-Show Countdown® network delivers:

- 94% of its screens in A & B counties
- 77% of the nation's 24+ screen megaplex theatres
- 29% higher attendance per screen than the industry average
- At least one of the three highest grossing theatres in 21 of the top 25 DMAs

NCN's circuit partners include:

Amstar Entertainment  
American Multi-Cinema  
Bainbridge Cinemas  
Carmike Cinemas  
CinemaStar Luxury Theatres  
Cobb Theatres  
Consolidated Amusement

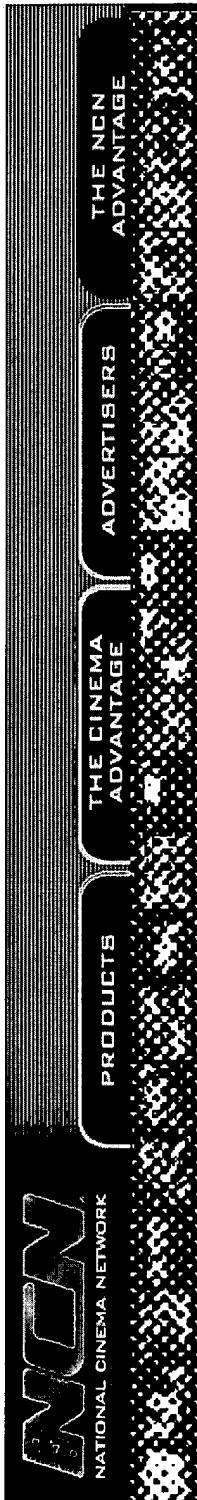
Entertainment Film Works  
Georgia Theatre Company  
Gulf States Theatres  
Kerasotes Theaters  
LoneStar Theatres  
Mann Theatres  
Marcus Theatres  
Metropolitan Theatres  
Movies Just Right (MJR)  
National Amusements Inc.  
Pacific Theatres  
Resort Theatres of America  
SoCal Cinemas  
Starplex Theatres  
Starship Theatres

### A Solid Reputation

NCN's innovative, high quality cinema media and strong circuit partnerships have attracted market leaders including Nike, BMW, AT&T, Microsoft, and McDonald's - as well as thousands of local and regional advertisers - to include NCN in their advertising and promotion plans.

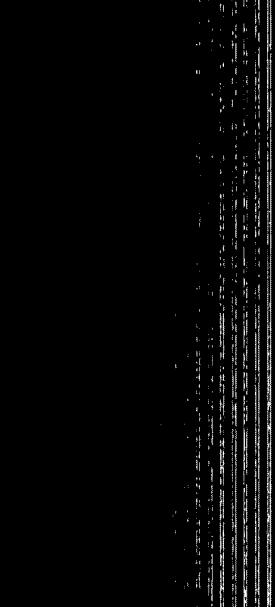
You know cinema  
advertising is effective.  
**Buy it from the company  
that introduced it.**

For advertising information, call  
**800 SCREEN 1.**  
Products • The Cinema ADvantage •  
Advertisers • The NCN ADvantage



### DTDS™

While others are talking about it, NCN is delivering digital cinema. Developed by NCN's technical operations team, DTDS™ is made up of networked digital video servers—placed in each theatre, and digital projectors—deployed on all screens in a complex, all controlled remotely from NCN's Network Operations Center in Kansas City. Entertainment and advertising content is beamed and managed via satellite to participating theatres. The servers can manage digital content including live events, distance learning, closed circuit meetings, and ultimately, full-length feature presentation.



**Complete our short survey for a chance  
to win a gift from NCN**

DTDS™ is a boon to NCN advertisers and exhibitors. It enables advertisers to target audiences on specific movie screens, as well as digital video monitors, kiosks, plasma screens and other display devices throughout the theatre. For exhibitor partners, DTDS™ provides a reliable, flexible platform that streamlines theatre operations and provides incremental revenue opportunities.

NCN's innovative, high quality cinema media and strong circuit partnerships have persuaded market leaders such as Nike, BMW, AT&T, E-Trade, McDonald's, and Flipside.com to include cinema advertising and promotions in their media plans.

A sample of NCN's digital entertainment  
program may be viewed at  
[www.NCNads.com/DTDS](http://www.NCNads.com/DTDS).

For advertising information, call  
**800.SCREEN.1.**  
Products • The Cinema ADvantage •  
Advertisers • The NCN ADvantage